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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,498	01/31/2006	Tomoki Morioka	285615US0PCT	3694

22850 7590 01/11/2010

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EXAMINER	
HOLLOMAN, NANNETTE	
ART UNIT	**PAPER NUMBER**
1612	

NOTIFICATION DATE	DELIVERY MODE
01/11/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/566,498	MORIOKA, TOMOKI	
	Examiner	Art Unit	
	NANNETTE HOLLOMAN	1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 October 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5,6,8,9 and 11-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5,6,8,9 and 11-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This Office Action is in response to the Request for Continued Examination filed on October 2, 2009. Applicants' arguments, filed October 2, 2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 103

(Previous Rejection)

Claims 5-6, 8-9, 11-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hinz (US Patent No. 5,785,962) in view of Fath (UK Patent No. GB 2321595 A). This rejection is maintained and further applied to new claim 23.

Applicant's Arguments

Applicant argues there is no motivation for one skilled in the art to select the specific shampoo of Hinz and combine it with the specific conditioner of Fath. Applicant further argues there is no rationale basis or evidence of how one skilled in the art would reasonably conclude that the combination would render obvious a hair treatment that

improves the reduction in signs of bending. Applicant also argues the results between example 11 and Comparative Example 11 and Example 10 and Comparative Example 10. Applicant's arguments have been fully considered but they are not persuasive.

Examiner's Response

It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See MPEP 2144, IV. As previously asserted, the property of reducing bending is not a limitation of the instant claims and therefore the references do not have to specifically teach this property to encompass the instant claims. Furthermore, the teaching of Fath that the treatment of shampooed hair with the disclosed conditioners has improved wet and dry combability of the hair, a relaxed and soft touch and enhanced shine (p. 11, ex. 3) would provide one of ordinary skill the motivation to combine the conditioners with the shampoo of Hinz.

In regard to the comparison of Example 11 and 10, there appears to be no error analysis when reporting the results that Applicant considers unexpected. It appears the difference in example 11 and Comparative Example 11 of (79 versus 71) recovery from the signs of bending just after treatment and (97 versus 92) one hour after treatment would appear to overlap depending on the % error. Thus Applicant has not shown that these values, especially 97 and 92 are not substantially the same. Therefore, it cannot be independently determined whether the values are different and thus it appears applicant's alleged unexpected results are not supported.

Applicants point to Comparative Examples 4a and 4b as the resulting recovery from the signs of bending of treated hair that would be obtained from the use of Hinz's shampoo alone and from the use of Fath's conditioner alone. This appears to be incorrect since both compositions of Comparative Examples 4a and 4b appear to be shampoo compositions. When looking to Table 2, which appears to be conditioner formulations, Comparative Example 8a contains components (b) and (c) with a result of 60% rightly after treatment and 88% one hour after treatment, which appears to give similar results of the apparent shampoo formulation of 4b. Comparing what Applicant states is like the shampoo of Hinz (Comparative Example 4a) results in a % recovery from the signs of bending of 68 just after treatment and 90 one hour after treatment with that of the conditioner which appears to be that of Fath (Comparative Example 8a) results in a % recovery from signs of bending of 60 just after treatment and 88 one hour after treatment. There is no control example wherein components a and b are not present, therefore, it can not be determined if the results are "unexpected" or merely additive because it can not be determined what the components a and b add, thus, it appears Applicant's alleged unexpected results are no more than additive and no more than what one of ordinary skill in the art would expect.

Assuming, purely *arguendo*, that the results are unexpected, Applicant's claims encompass more compounds than that disclosed in the tables in the specification, i.e. components a, b and c, therefore the examples are not commensurate in scope with the instant claims.

In regard to new claim 23, Fath discloses in the Examples, cetyl stearyl alcohol, which is a mixture of stearyl and cetyl alcohols[1], in an amount of about 5.00% by weight of the composition.

(New Rejection)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hinz (US Patent No. 5,785,962) in view of Fath (UK Patent No. GB 2321595 A) as applied to claims 5-6, 8-9, 11-23 above, and further in view of Fukuchi (US Patent No. 5,888,488.

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[1] Parchem, (Cetyl Stearyl Alcohol, Material Safety Data Sheet, [online], Retrieved [2009-12-23]). This reference was used to disclose that cetyl stearyl alcohol is a mixture of stearyl and cetyl alcohols and in not used as the basis of the rejection.

Hinz in view of Fath is discussed in the Office action filed July 23, 2008 and supra and differs from the instant claim insofar as it does not disclose at least one higher alcohol present in composition A in an amount of 1 to 20%.

Fukuchi discloses to improve the feeling after use of hair cosmetic compositions, such as the smoothness, luster and wetness, without making the hair sticky, components such as higher alcohols are added (column 1, lines 25-27 and 31-32); wherein the higher alcohol, i.e. behenyl alcohol, is used at 2% by weight of the composition of example 4, column 10.

It would have been obvious to have added higher alcohols, i.e. behenyl alcohol, to composition A or the composition of Hinz of Hinz in view of Fath motivated by the desire to improve the feeling after use, such as the smoothness, luster and wetness, without making the hair sticky as disclosed by Fukuchi.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 800am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H./
Examiner, Art Unit 1612

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612